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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/635,549	08/10/2000	Yevgeniy Eugene Shteyn	US000209US	7153
24737 7590 02/21/2008 PHILIPS INTELLECTUAL PROPERTY & STANDARDS P.O. BOX 3001 BRIARCLIFF MANOR, NY 10510			EXAMINER LIM, KRISNA	
			ART UNIT 2153	PAPER NUMBER
			MAIL DATE 02/21/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/635,549

Applicant(s)

SHTEYN, YEVGENIY EUGENE

Examiner

Krisna Lim

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. Claims 1-16 are pending for examination.
2. The disclosure is objected to because of the following informalities:
 - (a) throughout the specification, the text should be updated with the current status of the cited applications such as U.S. Patent Application Serial No., a filing date, U.S. Patent No., abandoned date and the issued date. Appropriate correction is required.
3. Examiner once again carefully reviewed and considered the entire specification that was originally submitted and Examiner would like to point out the following observations. First, the original claims 1-16 and the original specification did not direct to a consumer apparatus response to a user-input ... under control of (based on) ... an identifier thereof associated with the apparatus (e.g., see the original claims filed 8/10/2000). Second, the original claims 1-16 and the original specification did not mention the use of ... an identifier to retrieve the data from a server as amended claims. There is no teaching that the data can be retrieved from a server based on (the scope of based on is different from under control) a predetermined URL or the identifier as amended claims. On a contrary, the original specification was dealing with the use of a lookup table for converting the identifier to the URL in order to retrieve the content from a remote server. There is no mention of the identifier is used to retrieve the content from the server without converting to the URL. In addition, Examiner wonders how the identifier can be used to retrieve the content from the remote server without converting the URL to the IP address. There are only two lines (e.g., page 11, lines 2-3, "proxy 202 causes network 112 to contact an external server 206 to request a specific page indicated by a specific URL") in the original specification that teaches the use of URL to retrieve the content data from the remote server. What kind of a proxy device 202 that can perform such function? Moreover, there is no teaching in the original application as amended drawing (4/4/07); especially the newly added figure 3 which contains a new matter and it will not be entered. The newly added specification does not sufficiently describe this newly added figure either. Applicant is reminded that each elements or items of drawing must be labeled and sufficiently described in detail. And, the applicant is suggested to cite where in the specification that teaches the newly added features of figures 1-3.
4. The amendment filed 4/4/07 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as mentioned in paragraph 2 above and as follows:

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a) "a user-input for initiating retrieval of data from a server under control of (now based on) predetermined URL or an identifier thereof associated with the apparatus"; and

b) "the predetermined URL or identifier thereof being stored on the home network". Applicant is required to cancel the new matter in the reply to this Office Action.

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The original specification did not direct to a consumer apparatus response to a user-input ... under control of (based on) ... an identifier thereof associated with the apparatus. The original specification did not mention the use of ... an identifier to retrieve the data from a server as amended claims. There is no mention of the identifier is used to retrieve the content from the server without converting it to the URL in order to retrieve the contend data from the server. **This original proxy device 202 is merely a black magic rectangular box (e.g., see page 11, lines 2-3) that proclaimed to perform such and such function without complying with the written description requirement.**

7. Claims 1-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The original specification did not direct to a consumer apparatus response to a user-input ... under control of (based on) ... an identifier thereof associated with the apparatus. The original specification did not mention the use of... an identifier directly to retrieve the data from a server as amended claims. There is no directly use of the identifier to retrieve the content from the server without converting to the URL. This original proxy device 202 is merely a black magic rectangular box (e.g., see page 11, lines 2-3) that proclaimed to perform such and such function without complying with the enablement requirement.

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8. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted element is a lookup table for converting the identifier to the URL in order to retrieve the content from a remote server. b) and the conversion the URL to an IP address in order to retrieve the content from a remote server.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

10. Claims 1-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Humpleman et al. [U.S. Patent No. 6,288,716].

11. Humpleman et al. anticipated (e.g., see Figs. 1-16) the invention substantially as claimed. Taking claim 1 as an exemplary claim, the reference disclosed a consumer apparatus (home device, col. 1, lines 21-36) responsive to a user-input for initiating retrieval of data from a server under control of a predetermined URL (e.g., see the abstract, col. 2 (line 36) to col. 3 (line 5), col. 4 (lines 33-41), col. 11 (lines 1-21)), the

data represented context information about the context of usage of the consumer apparatus (col. 7).

12. As to claim 2, Humpleman et al. further anticipated the consumer apparatus configured for use and inclusion on a home network and having an Internet-access functionality (e.g., see the abstract, col. 2 (line 36) to col. 3 (line 5), col. 4 (lines 33-41), col. 11 (lines 1-21)) through the home network, the predetermined URL therefor being stored on the home network.

13. As to claim 3, Humpleman et al. further anticipated the consumer apparatus comprising a memory for storage of the URL (col. 7, col. 11, lines 1-21).

14. As to claim 4, Humpleman et al. further anticipated the consumer apparatus, wherein: the consumer apparatus has a remote control device (e.g., see col. 1, lines 4-7); and the device has a dedicated button (e.g., see col. 1, lines 45-51, col. 2, lines 39-41) for initiating the retrieval of the data.

15. Claims 6-16 are rejected for the same rationale as claims 1-4.

16. Applicant's arguments with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection.

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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The references are cited in the Form PTO-892 for the applicant's review.

A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the application (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krisna Lim whose telephone number is 571-272-3956. The examiner can normally be reached on Monday to Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess, can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KI

February 17, 2008

/Krisna Lim/
Primary Examiner, Art Unit 2153



KRISNA LIM
PRIMARY EXAMINER